

### **REMARKS**

#### **Status of the Claims**

Claims 2-4, 6 and 7 are currently pending in the application. Claims 2-6 stand rejected. The Examiner objects to claims 5 and 6. Claims 2-4 and 6 have been amended as set forth herein. Claim 5 has been cancelled herein. All amendments and cancellations are made without prejudice or disclaimer. New claim 7 has been added herein. No new matter has been added by way of the present amendments. Specifically, the amendment to claims 2-4 are to update their dependency in light of cancellation of claim 5. The amendment to claim 6 is supported by the specification at, for instance, page 36, Table 4. New claim 7 is supported in the specification at least at page 10, lines 4-8. Reconsideration is respectfully requested.

#### **Information Disclosure Citation**

The Examiner has not provided Applicant with an initialed copy of the SB-08 form filed with the Information Disclosure Statement filed July 13, 2006. An initialed copy thereof is respectfully requested from the Examiner in the next communication.

#### **Objections to the Claims**

The Examiner objects to claims 5 and 6. (See, Office Action of December 18, 2006, at page 2, hereinafter, "Office Action"). Claim 5 has been cancelled herein without prejudice or disclaimer, thus obviating the objection to claim 5. As to claim 6, the Examiner states that the phrase "an ash content in a surface layer . . . is not higher than 35% by mass" is superfluous and

not necessary. (*Id.*). The Examiner suggest canceling this phrase from the claim. (*Id.*). Applicants traverse the objection as to claim 6 as set forth herein.

The phrase "an ash content in a surface layer .... is not higher than 35% by mass" defines the specific value of the ash content in the surface layer, while the phrase "the percentage of ash content in the surface layer is lower than a total percentage of ash content in the paper" only defines ash content in the surface layer is lower than a total percentage and recites no specific value of the ash content.

Thus, reconsideration and withdrawal of the objection to claim 6 are respectfully requested.

#### **Rejections Under 35 U.S.C. § 103(a)**

Claims 2-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over in view of Yamazaki et al., EP 0791688 A1 (hereinafter, "Yamazaki et al."). (*See*, Office Action, at page 2). Claim 5 has been cancelled herein without prejudice or disclaimer, thus obviating the rejection of claim 5. Applicants traverse the rejection as to the remaining claims as hereinafter set forth.

The Examiner provides no reasoning to justify the rejection other than that already provided in the Office Action of May 8, 2006. (*Id.* at pages 3-4). The Examiner further states, under the Examiner's objections to the claims at page 2, that the claims do not recite the feature "the amount of ash in the surface layer of the wrapper paper is smaller than that in the central portion," which phrase Applicants commented upon in their prior response. (*Id.* at page 2).

Although Applicants do not agree that the presently claimed invention is obvious in light of Yamazaki et al., or that the Examiner has properly established a *prima facie* case of obviousness, claim 6 has been amended herein without prejudice or disclaimer. As amended, claim 6 recites that the percentage of ash content in a surface layer on each of a top side and a bottom side of the wrapper paper is lower than a total ash content in percentage of the wrapper paper. Furthermore, new claim 7 recites that the amount of calcium carbonate in a surface layer on each of a top side and a bottom side of the wrapper paper is decreased while keeping the amount of calcium carbonate contained within the wrapper paper. These added elements logically require that the amount of ash or calcium carbonate in the surface layer in question is smaller than that in the central portion of the wrapper paper. Thus, the claims, as amended, do recite that which Applicants have commented upon as a distinguishing feature of the presently claimed invention.

Thus, the wrapper papers of claims 5 and 6 can not be obtained by a conventional Fourdrinier machine, as described in the present specification at, for instance, page 9, line 21 to page 10, line 7. The wrapper paper of the present invention can, however, be prepared by the method described in the present specification at page 10, lines 8-20. That is, the presently claimed invention may be obtained by using a double-sided dehydration-type wire part or twin wire type wire part.

Yamazaki et al. not disclose or suggest such a method of preparing a wrapper paper, using a double-side dehydration type wire part or twin wire type wire part and thus there is no suggestion of the claimed wrapper. Thus, the Examiner has failed to establish a *prima facie* case of obviousness with respect to the disclosure of Yamazaki et al. because Yamazaki et al. do not

disclose or suggest all of the limitations of the presently claimed invention, especially as recited in amended claim 6 and new claim 7. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (*See, In re Vaeck*, 947 F.2d 488 at 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991)).

Since no independent reasoning is provided for the rejection of dependent claims 2-4, dependent claims 2-4 are also believed to be non-obvious in light of Yamazaki et al. for, *inter alia*, depending from a non-obvious base claim, independent claim 6.

For at least these reasons, and those provided in Applicants' reply of September 8, 2006, especially at pages 4 and 5, reconsideration and withdrawal of the obviousness rejection of claims 2-4 and 6 are respectfully requested.

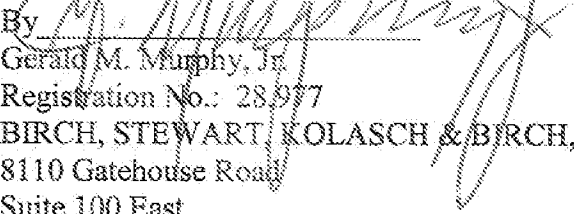
**CONCLUSION**

If the Examiner has any questions or comments, please contact Thomas J. Siepmann, Ph.D., Registration No 57,374, at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: May 18, 2007

Respectfully submitted,

By   
Gerald M. Murphy, Jr.  
Registration No.: 28,977  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicants